



**Terminal Disclaimer To Obviate A Double  
Patenting Rejection Over A Prior Patent**

Docket No.  
U6090-3

In Re Application Of: **Stephen Y. Chou**

Serial No.  
10/046,594

Filing Date  
October 29, 2001

Examiner  
Mathieu D. Vargot

Group Art Unit  
1732

Invention: **Improved Release Surfaces, Particularly For Use In Nanoimprint Lithography**

Owner of Record: **UNIVERISTY OF MINNESOTA**

**TO THE COMMISSIONER FOR PATENTS:**

The above-identified owner of record of a **100** percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173, as presently shortened by any terminal disclaimer, of prior Patent No. **6,309,580**. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors and/or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of the prior patent, as presently shortened by any terminal disclaimer, in the event that it later expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. 1.321, has all claims cancelled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

Check either box 1 or 2 below, if appropriate.

1. ☐ For submissions on behalf of an organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2. ☒ The undersigned is an attorney of record.

  
Signature

Dated: **July 7, 2004**

**Daniel D. Sierchio**

Typed or Printed Name

07/13/2004 WABRHAM1 00000089 501358 10046594

01 FC:2814

55.00 DA

- ☒ Terminal disclaimer fee under 37 C.F.R. 1.20(d) included.  
☐ PTO suggested wording for terminal disclaimer was unchanged.  
☐ Certification under 37 C.F.R. 3.73(b) is required if terminal disclaimer is signed by the assignee.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,594	10/29/2001	Stephen Y. Chou	600.426US2	3744

7590 06-30/2004

DOCKETING ADMINISTRATOR  
LOWENSTEIN SANDLER PC  
65 Livingston Avenue  
Roseland, NJ 07068-1791

EXAMINER
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VARGOT, MATHIEU D

ART UNIT	PAPER NUMBER
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1732

DATE MAILED: 06/30/2004

+1  
7/30/04 DD

Please find below and/or attached an Office communication concerning this application or proceeding.



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51

APPLICATION NO. / CONTROL NO. 046,594	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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EXAMINER
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ART UNIT	PAPER
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20040626

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

The reply filed on April 8, 2004 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s): In the remarks, at page 19 of the faxed communication, applicant states that a terminal disclaimer has been filed to obviate double patenting rejections with respect to both Chou patents, when in fact a terminal disclaimer was filed only for the -905 patent. A request that the double patenting rejections be withdrawn in light of this fact is confusing and in fact non-responsive to the rejection, since no terminal disclaimer was filed for the -580 patent. See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

*M. Vargot*

Mathieu D. Vargot  
Primary Examiner  
Art Unit: 1732

6/26/04